

REMARKS

Reconsideration of the above-identified application in view of the present amendment is respectfully requested.

Claims 2-8, 11-12, 17-23 and 25 are canceled. Claims 27-37 are added in the present application.

The indication that claims 3, 5-8, 18, 20-23 and 25 would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims, is acknowledged with appreciation.

Claim 27 is claim 3 rewritten in independent form. Claim 28 is claim 5 rewritten in independent form. Claim 29 is claim 6 rewritten in independent form. Claim 30 is claim 7 rewritten in independent form. Claim 31 is claim 8 rewritten in independent form. Claim 32 is claim 18 rewritten in independent form. Claim 33 is claim 20 rewritten in independent form. Claim 34 is claim 21 rewritten in independent form. Claim 35 is claim 22 rewritten in independent form. Claim 36 is claim 23 rewritten in independent form. Claim 37 is claim 25 rewritten in independent form.

Thus, claims 27-37 should be allowed.

Claims 1, 2, 4, 9, 10, 13-17, 19, 24 and 26 have been rejected as being unpatentable over the combination of the patents to Pfenninger Jr, et al., Cartwright et al. and Kidzun.

The invention solves a specific problem namely, walk out of gaskets in steering column housings. The problem solved by the invention is not discussed in any of the prior art. The

prior art has failed to provide any solution to the problem solved by the invention. Thus, the combination of references cited is not obvious.

It is respectfully submitted that to establish obviousness of a claimed invention, the prior art reference or reference combination, must teach or suggest all the claim limitations. In addition, there must be some suggestion or motivation to a person having ordinary skill in the art to combine reference teachings. (MPEP §706.02(j)).

There is no suggestion in any of the patents to Pfenninger, Jr. et al., Cartwright et al. and Kidzun, to modify any of the references in view of another of the references. Further, the combining of Pfenninger Jr. et al., Cartwright et al. and Kidzun could only result from hindsight reconstruction of applicant's vehicle steering column as set forth in claims 1, 2, 4, 9, 10, 13-17, 19, 24 and 26.

The Examiner may not use improper hindsight reconstruction to find the claimed invention obvious by using the present invention as a guide. The Examiner may not use the claims as an instruction manual to find the appropriate prior art that might render the claims obvious. The issue is whether it would have been obvious to modify the reference without having access to the application that is under examination to arrive at the claimed invention. As stated by the Federal Circuit, "the actual determination of the issue [of obviousness] requires an evaluation in the light of the findings in those inquiries of the obviousness of the claimed invention as a whole, not merely the differences between the

claimed invention and the prior art". (Graham v. John Deer Co., 383 U.S. at 17, 148 USPQ at 476)

Thus, it is not correct for the Examiner to merely focus on the difference between the prior art and the claimed invention, and then to state that the differences themselves or individually are obvious. The claimed invention as a whole is to be considered. Further, it is impermissible for the Examiner to use the application itself as the basis or reason for formulating the obviousness rejection. The Federal Circuit has stated:

[i]t is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention".

(In re Fritch, 972 F.2d 1260, 23 USPQ 2d 1780 (Fed. Cir. 1992) (quoting In re Fine, 837 F.2d 1071, 1075, 5 USPQ 2d 1696, (Fed. Cir. 1988)).

The bearing structure in the patent to Pfenninger Jr., et al. would have to be modified fourfold to result in a structure similar to claim 1 as follows: 1) the rod 16 would have to be modified to a steering wheel column which attaches to a steering wheel; 2) bushing parts 14 and 15 would have to be eliminated; 3) the resilient gasket 22 would have to be provided with a cylindrical inner surface and; 4) part 18 would have to be eliminated so the gasket can engage the outer race of the bearing.

The office action stated that the patent to Kidzun discloses a steering column including a gasket member 8 having a cylindrical inner surface engaging the outer race of a bearing and a ribbed outer surface.

Col. 4 lines 40-51 in Kidzun state that the ribbed outer surface of the gasket 8 is squeezed and deformed (once it is seated correctly in the bearing 2 upon the shaft 1) into a continuous cross section, i.e. the portion 11 of the ridge 9 fully occupies the recess 12. Thus, the ribs are compressed when the gasket is seated in the bearing. The squeezed gasket 8 functions as a compression spring between the steering shaft and the steering column to take up tolerances in the bearing. The gasket of Kidzun is not ribbed on its outer surface when it is seated in the bearing.

Thus, Kidzun does not teach the limitation of claim 1 of a gasket having portions interdigitated with the ribs in the outer and inner rings (of Pfenninger Jr., et al.) to resist relative axial movement between the gasket and the housing, and the axially adjacent annular ribs and the portions of the resilient material of the gasket interdigitated with the axially adjacent annular ribs comprising means for preventing the gasket from walk out from the housing.

There is no motivation to combine the gasket of Kidzun with the bearing structure of Pfenninger Jr., et al. because the gasket in Kidzun does not have ribs when seated in the bearing.

Regarding claim 16, the Examiner does not seem to have given any patentable weight to the structural limitations

regarding the specific structure of the housing i.e., first and second axially spaced apart ring shaped cavities that extend radially into the inner surface of the cylindrical portion of the housing, the first and second ring shaped cavities being spaced apart by a ring shaped projection of the cylindrical portion of the housing, and that each of the first and second cavities has a series of annular ribs that at least partially extend around the axis of the input shaft and around the outer race of the bearing in the respective first and second cavities where axially adjacent annular ribs that are separated by an annular groove.

The cited prior art combination does not disclose a housing with these claimed structural features. It is respectfully submitted that a prima facie case of obviousness has not been established regarding claim 16 because the prior art reference combination does not teach or suggest all of the above-listed structural claim limitations.

Further regarding claim 16, no patentable weight has been afforded to the limitations regarding the specific structural locations of the bearings and gaskets in the cavities of the housing. The cited prior art combination does not disclose these specific structural limitations and including the structural limitations of the housing structure recited above. It is respectfully submitted that a prima facie case of obviousness has not been established regarding claim 16 because the prior art reference combination does not teach or suggest all the claimed structural limitations.

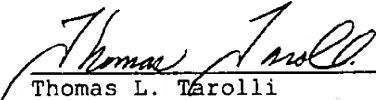
Thus, claim 16 should be allowable.

Claims 2, 4, 9, 10, and 13-15 depend from claim 1 and define over the prior art for the same reasons as claim 1 and for the specific limitations recited therein. Claims 17, 19, 24 and 26 depend from claim 16 and define over the prior art for the same reasons as claim 1 and for the specific limitations recited therein. Thus, claims 2, 4, 9, 10, 13-15, 17, 19, 24 and 26 should be allowable.

In view of the foregoing, it is respectfully submitted that the above-identified application is in condition for allowance, and allowance of the above-identified application is respectfully requested.

Please charge any deficiency or credit any overpayment in the fees for this amendment to our Deposit Account No. 20-0090.

Respectfully submitted,


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